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REMARKS

Claims 1-20 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Claims 1-4, 6-10 and 12-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,860,457 to Beissbarth. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the Examiner has not yet met the Examiner's burden of establishing a *prima facie* case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

Claim 1 defines a method of indicating a position of a steerable wheel of a vehicle including, among other things, providing a wheel position indicator having an on state and an off state. The wheel position indicator provides a visual indication of the position of the

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steerable wheel when the wheel position indicator is in the on state. The wheel position indicator does not provide a visual indication of the position of the steerable wheel when the wheel position indicator is in the off state. The method further includes placing the wheel position indicator into the on state when the vehicle is in a predetermined driving condition and placing the wheel position indicator into the off state when the vehicle is not in the predetermined driving condition.

The prior art of record does not disclose or suggest the above noted features of claim 1. In the Office Action, claim 1 has been rejected as being unpatentable over the Beissbarth '457 patent. Applicants note that the Beissbarth '457 patent discloses a device used by a person servicing a vehicle in order to determine the castor, the kingpin inclination and the track differential angle of a vehicle in order to be able to properly service the vehicle. The apparatus is configured to be removably attached to a steerable wheel 2 of a vehicle such that the service person can measure a large number of steering angles of a large number of vehicles and service the same. Accordingly, the device of the Beissbarth '457 patent is never used when the vehicle is moving.

Claim 1 states that the method of indicating a position of a steerable wheel of a vehicle includes placing the wheel position indicator into the on state when the vehicle is in the predetermined driving condition and placing the wheel position indicator into the off state when the vehicle is not in the predetermined driving condition. According to the Office Action, the Beissbarth '457 patent does not include placing the wheel position indicator into an on state or an off state. The Office Action then goes on to state that one of ordinary skill in the art would have readily recognized that when the vehicle is of use, the indicator should be in the on state to provide information and when the vehicle is not in use or not driven, the indicator should be put in the off state to save power. However, as stated above, the vehicle is never driven during use of the device of the Beissbarth '457 patent. Therefore, any vehicle connected to the device of the Beissbarth '457 patent would not be driven and therefore the device would not be in an on state when the vehicle is in a predetermined driving condition. Accordingly, there is no suggestion or motivation for modifying the Beissbarth '457 patent as set forth in the Office Action. Accordingly, claim 1 is in condition for allowance.

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Claims 2-8 depend from claim 1, and since claim 1 defines unobvious patentable subject matter as discussed above, claims 2-8 define patentable subject matter. Accordingly, claims 2-8 are in condition for allowance.

Furthermore, the prior art of record does not disclose or suggest the above noted features of claim 2. As stated above in regard to claim 1, the Beissbarth '457 patent cannot be used with a vehicle that is in any driving condition. Accordingly, the Beissbarth '457 patent cannot be used with a vehicle in an off-road driving condition. Therefore, claim 2 is in condition for allowance for this additional reason.

Furthermore, in regard to claim 3, there is no suggestion or motivation for placing the device of the Beissbarth '457 patent into an on state when a steerable wheel has a slip angle above or equal to predetermined amount. As discussed above, the vehicle connected to the device of the Beissbarth '457 patent would never be moving. Accordingly, the vehicle connected to the device of the Beissbarth '457 patent would never have a slip angle above or equal to a predetermined amount as the steerable wheel would not be moving or rotating. Therefore, claim 3 is in condition for allowance for this additional reason.

In regard to claim 4, the prior art of record does not disclose or suggest that a visual indication of the position of the steerable wheel includes a circular display mechanically connected to a steering column of the vehicle. According to the Office Action, it is not clear where and what the display is mounted on and connected to in the Beissbarth '457 patent. However, the Beissbarth '457 patent clearly shows a display 38 in the instrument 12 that is selectively connected to a vehicle. Therefore, there is no suggestion or motivation for connecting an item to a steering column that is designed to be removably connected to a wheel. Furthermore, even if there was a suggestion or motivation for making the modification of the Beissbarth '457 patent as set forth in the Office Action, any such combination would not include a circular display. Accordingly, claim 4 is in condition for allowance for these additional reasons. Accordingly, claims 2-8 are in condition for allowance.

Claim 9 defines a wheel position indication system for a vehicle including, among other things, a steerable wheel and a wheel position indicator having an on state and an off state. The wheel position indicator provides a visual indication of the position of the steerable wheel

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when the wheel position indicator is in the on state. The wheel position indicator does not provide a visual indication of the position of the steerable wheel when the wheel position indicator is in the off state. A controller selectively alters the wheel position indicator between the on state and the off state. The controller places the wheel position indicator into the on state when the vehicle is in an off road condition and places the wheel position indicator into the off state when the vehicle is not in the off road condition.

The prior art of record does not disclose or suggest the above noted features of claim 9. As discussed above, the device of the Beissbarth '457 patent is a device configured to be removably connected to a wheel of a vehicle such that a servicer of the vehicle can properly service the vehicle. Accordingly, the Beissbarth '457 patent would never be used with a vehicle that is being driven, much less a vehicle in an off-road condition. Accordingly, claim 9 is in condition for allowance.

Claims 11-14 depend from 9, and since claim 9 defines unobvious patentable subject matter as discussed above, claims 10-14 define patentable subject matter. Furthermore, in regard to claim 10, the prior art of record does not disclose or suggest that the visual indication of the position of the steerable wheel includes a circular display mechanically connected to a steering column of a vehicle. As discussed above in regard to claim 4, there is no suggestion or motivation for mechanically connecting any display of the device of the Beissbarth '457 patent to a steering column of a vehicle. Furthermore, even if there was a suggestion or motivation for making the modification as set forth in the Office Action, any such display would not be a circular display. Accordingly, claims 10-14 are in condition for allowance.

Claim 15 defines a wheel position indication system for a vehicle including, among other things, a wheel position indicator having an on state and an off state. The wheel position indicator provides a visual indication of the position of the steerable wheel when the wheel position indicator is in the on state. The wheel position indicator does not provide a visual indication of the position of the steerable wheel when the wheel position indicator is in the off state. A controller selectively alters the wheel position indicator between the on state and the off state. The controller places the wheel position indicator into the on state when the steerable wheel has a slip angle above or equal to a predetermined amount and places the wheel position

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indicator into the off state when the steerable wheel has a slip angle below the predetermined amount.

The prior art of record does not disclose or suggest the above noted features of claim 15. Specifically, the prior art of record does not disclose or suggest a controller that places a wheel position indicator into an on state when a steerable wheel has a slip angle above or equal to a predetermined amount and places the wheel position indicator into the off state when the steerable wheel has a slip angle below the predetermined amount. According to the Office Action, one of ordinary skill in the art would have readily recognized that it would be desirable to display information only when necessary, such as when the slip angle is above a predetermined amount. However, since the device of the Beissbarth '457 patent could only be connected to a vehicle that is not moving, there is no suggestion or motivation for altering the device when such modification would only apply when a vehicle that the device is connected to is moving. Accordingly, claim 15 is in condition for allowance.

Claims 16-20 depend from claim 15, and since claim 15 defines unobvious patentable subject matter as discussed above, claims 16-20 define patentable subject matter. Furthermore, in regard to claim 16, the prior art of record does not disclose or suggest that the visual indication of the position of the steerable wheel includes a circular display mechanically connected to a steering column of a vehicle. As discussed above in regard to claim 4, there is no suggestion or motivation for mechanically connecting any display of the device of the Beissbarth '457 patent to a steering column of a vehicle. Furthermore, even if there was a suggestion or motivation for making the modification as set forth in the Office Action, any such display would not be a circular display. Accordingly, claims 10-14 are in condition for allowance.

Claims 5, 7 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Beissbarth '457 patent in view of U.S. Patent No. 5,742,918 to Ashrafi et al. As stated above, the Beissbarth '457 patent is used by a person servicing a vehicle in order to properly align the wheels of a vehicle independent of a steering column. Therefore, the Beissbarth '457 patent directly teaches against any measurement of the angle of the steerable wheel using a steering column such that there is no suggestion or motivation for combining the

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Beissbarth '457 patent and the Ashrafi et al. '918 patent as set forth in the Office Action.
Accordingly, claims 5, 11 and 17 are in condition for allowance.

All pending claims 1-20 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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